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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/091,039 | 03/04/2002 | James Hammer | 1342-61338 | 6479 |
| 7590 | 12/01/2004 | | EXAMINER | |
| One World Trade Center Suite 1600 121 S.W. Salmon Street Portland, OR 97204 | | | NGUYEN, THUKHANH T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1722 | |

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/091,039

Applicant(s)

HAMMER ET AL.

Examiner

Thu Khanh T. Nguyen

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-39 and 52.

Claim(s) withdrawn from consideration: 40-51 and 53.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

DETAILED ACTION

1. The proposed amendment has introduced new issue into the claim, in which the apparatus is used for forming a roughened surface texture on an uncured masonry block. This new limitation would require further consideration.
2. Applicant's arguments filed November 15, 2004 have been fully considered but they are not persuasive.
3. In response to applicant's argument that there is no suggestion to combine Yoshiyuki and Yasuo, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Yoshiyuki discloses an apparatus for forming concrete block having a plurality of projects on its surface, while Yasuo discloses a concrete block having a plurality of conical projections on its surface to improve the integrity (firmness, firm adherence; Merriam-Webster's Dictionary 10th Ed. 1998) of the concrete block. Because both references are related to the forming of concrete blocks, they are combinable.
4. When the projections are conical, or having a slant surface of the pyramidal shape, the firmness of the concrete block is improved. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify Yoshiyuki by

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providing the projections having conical shape in order to form concrete block having conical projections on its surface as taught by Yasuo.

It has also been well known in the molding art that the molded product takes the shape of the mold; therefore in order to form a product having conical projections on its surface, the mold surface should also have conical projections. Therefore, when incorporate the conical projections, or projections with slant surfaces as taught by Yasuo into Yoshiyuki, it's no more than just a shape modification. The operation of Yoshiyuki remains the same. There is no invention in merely changing the shape or form of an article without changing its function except in a design patent. See *Eskimo Pie Corp. v. Levous et al.*, 3 USPQ 23 and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)

5. In response to applicant's argument that Yasuo is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Yasuo is related to the concrete block having conical projections on its surface, while Yoshiyuki and the current invention are related to an apparatus for forming concrete blocks having projections on its surface. Because the shape of the final product is corresponding to the shape of the mold, it would have been obvious to a skilled artisan to change the shape of the mold in order to form a concrete block with stronger integrity, or firmness. Therefore, Yasuo is in the field of applicant's endeavor.

In regard to Applicant's argument that Yoshiyuki and Yasuo teach away from the claims, in which the reference teach "apparatus for casting a mirror image of a mold wall into the surface

of concrete, rather than an apparatus for creating a roughened surface texture on an uncured block as it is removed from a mold." As the Applicant would agree that when casting the mirror image of a mold wall into the surface of concrete, Yoshiyuki would also create a roughened surface texture on the forming block. As the examiner understand, the roughened surface or the current invention was only formed as it come into contact with the tapered projections on the mold surface during the removal of the block. However, this is a functional limitation that does not result in the differences of the apparatus. Yoshiyuki and Yasuo's mold could also form a block with conical projections on its surface, as the block is removed from an expandable mold, or a mold in which the walls are laterally removable. Therefore, the limitation on how to form the projections on the blocks cannot be used to determent patentability of an apparatus claim, when all structure limitations are taught by prior art. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device *is*, not what a device *does*." Hewlett- Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (Emphasis in original)

6. The Applicant have repeatedly asserted that Yasuo and Yoshiyuki teach away from each other, in which Yasuo teaches increasing contacting surface and Yoshiyuki teaches minimizing the contact area. However, these references are related to two different things. While in Yoshiyuki having tapered mold walls to **facilitate the removal of the product** from one end to the other, the tapered wall does not really teach minimizing the contact area. If the contact area between the block and the projections are limited, the blocks will not be formed properly. The material could get loose and the formed projections on the block surface would not replicate the

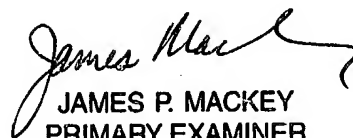
shape the projections on the mold wall. Yasuo, on the other hand, teaches that the projections having slant surfaces to increase the contacting surface at each projection so that **less compression force is required**. Thus, Yasuo and Yoshiyuki concern about two different limitations, and these limitations are not teaching away from each other.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Khanh T. Nguyen whose telephone number is 571-272-1136. The examiner can normally be reached on Monday- Friday, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin L. Utech can be reached on 571-272-1137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TN


JAMES P. MACKEY
PRIMARY EXAMINER
11/29/04